

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3722

In re

Patent Application of

Eric E. Blohm et al.

Application No. 10/607,233

Confirmation No. 5865

Filed: June 26, 2003

Examiner: Pradeep Choudary Battula

"PRINTED PRODUCT BINDING METHOD"

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is filed in response to the Office action dated December 3, 2008 and further to the Notice of Appeal filed February 27, 2009. This Brief is Applicants' third successive attempt to convey an appeal to the Board of Patent Appeals and Interferences (the first two attempts resulting in the Examiner re-opening prosecution).

The \$510 fee required by 37 CFR 41.20(b)(2) was paid with the first Appeal Brief, and as such, only the difference of \$30 between the current fee (\$540) and the originally paid fee is currently due (MPEP 1207.04). Please charge \$30 to Deposit Account No. 13-3080. Please charge any additional fees or credit any overpayment associated with the filing of this brief to Deposit Account No. 13-3080.

(i) *Real party in interest*

The real party in interest is Quad/Graphics, Inc., N63w23075 Highway 74, Sussex, WI 53089 as recorded by the assignment at reel/frame 014243/0776.

(ii) *Related appeals and interferences*

There are no related appeals or interferences.

(iii) *Status of claims*

Claims 1-26 and 28-31 are currently pending in the application. Claim 27 is canceled. Of the pending claims, no claims are allowed, no claims are objected to, and Claims 1-26 and 28-31 are rejected. Claims 1-26 and 28-31 are presently being appealed.

(iv) *Status of amendments*

No amendments have been filed subsequent to final rejection.

(v) *Summary of claimed subject matter*

Independent claim 1 defines a binding method comprising generating a pre-personalized book on a binding line for a specific individual, rejecting selective pre-personalized books, and generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual (*page 2, lines 6-9; page 3, lines 29-31; page 5, lines 10-20; page 6, lines 7-9; page 6, lines 30-34; page 7, lines 21-25; Figs. 1-6*).

Independent claim 9 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized book for each recipient on a binding line, rejecting one of the pre-personalized books, identifying the recipient of the rejected pre-personalized book, and generating an alternate piece that replaces the rejected pre-personalized book (*page 2, lines 10-14; page 4, lines 26-29; page 5, lines 10-11; page 5, line 24-page 6, line 16; page 6, lines 30-34; Figs. 1-5*). The alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (*page 6, lines 11-14*).

Independent claim 15 defines a method of replacing a rejected book on a binding line. The method comprises generating a mailing list of recipients having a mailing order, assembling a pre-personalized book on the binding line for each recipient according to the mailing list, rejecting selective pre-personalized books, generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and replacing the rejected pre-personalized book with the alternate piece (*page 5, lines 10-20; Figs. 1-3*). The alternate piece is positioned on the binding line to maintain the mailing order (*page 2, lines 15-20; page 5, line 33-page 6, line 5; page 6, lines 32-34; Figs. 4 and 5*).

Independent claim 21 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized printed product off-line for selected recipients on the mailing list, loading the pre-personalized printed products adjacent a binding line, assembling a book for each recipient including a respective pre-personalized printed product, rejecting selective recipients' books, removing the rejected books from the binding line, and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product (*page 2, lines 21-26; page 5, lines 10-20; page 6, lines 7-9; page 7, lines 3-25; Figs. 1-3, 6*).

Independent claim 24 defines a binding method comprising generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature, rejecting selective pre-personalized books, reprinting the pre-personalized signature of one of the rejected pre-personalized books, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (*page 2, line 27-page 3, line 4; page 4, line 26-page 5, line 6; page 7, lines 3-25; Figs. 1-3, 6*).

Independent claim 28 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized printed product for each recipient, assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece, rejecting selective books, removing the rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (*page 5, lines 10-20; Figs. 1-3; page 5, line 33-page 6, line 9; page 6, lines 22-34; Figs. 4 and 5*).

Independent claim 31 defines a method of replacing a rejected book on a binding line. The method comprises generating a mailing list of recipients, assembling a pre-personalized book on the binding line for each recipient, rejecting selected pre-personalized books, replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium (*page 4, line 26-page 5, line 20; page 6, lines 7-9; Figs. 1-3*).

(vi) *Grounds of rejection to be reviewed on appeal*

1. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 14 and 20 fail to comply with the written description requirement under 35 U.S.C. §112, first paragraph.
2. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 25 and 26 fail to comply with the definiteness requirement under 35 U.S.C. §112, second paragraph.
3. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 1, 3, 4, 6, 9, 10, 11, 13, and 21-23 are anticipated under 35 U.S.C. §102(b) by United States Patent No. 6,347,260 ("Graushar").
4. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 24 and 25 are anticipated under 35 U.S.C. §102(b) by United States Patent No. 4,395,031 ("Gruber").
5. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 1-25, and 28-31 are anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,694,219 ("Graushar '219").
6. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 2, 5, 7, 8, 12, 14, and 29 are unpatentable under 35 U.S.C. §103(a) over Graushar in view of Graushar '219.
7. Applicants appeal the rejection made in the Office action dated December 3, 2008, and request that the Board review whether claims 24 and 26 are unpatentable under 35 U.S.C. §103(a) over Gruber in view of U.S. Patent No. 3,819,173 ("Anderson").

(vii) *Argument*

1. Claim Rejections under 35 U.S.C. §112, ¶1

The Examiner rejects claims 14 and 20 as failing to comply with the written description requirement under 35 U.S.C. §112, first paragraph.

Claims 14 and 20 were rejected under the same section for the same stated reason in the Office action dated May 19, 2006 (see page 3). Applicants responded to these rejections with the remarks of the response mailed November 16, 2006, in response to which the Examiner withdrew the rejections. The Examiner has now repeated the rejection, based on an issue resolved two years ago, in the Office action dated December 3, 2008. The circular nature of the examination in this regard has been significantly prejudicial to Applicants in creating undue delay and cost.

Claim 14

Claim 14, read in its entirety (including the subject matter of claim 9 from which it depends), defines a binding method comprising:

generating a mailing list of recipients,
generating a pre-personalized book for each recipient on a binding line,
rejecting one of the pre-personalized books,
identifying the recipient of the rejected pre-personalized book, and
generating an alternate piece that replaces the rejected pre-personalized book,
wherein the alternate piece includes a notification to the recipient regarding the
status of their pre-personalized book,
wherein the alternate piece is in electronic format.

Applicants submit that the subject matter of the rejected claims, specifically the alternate piece being in electronic format, is duly described in the specification at multiple locations. For example, reference is made to electronic format replacement pieces in the specification at page 3, lines 21-22; page 3, lines 29-31; page 5, lines 10-15; page 5, lines 17-20; page 6, lines 7-9; and page 6, line 30 to page 7, line 2.

According to the MPEP Section 2163, an adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. Additionally, the burden of proving the written description to be deficient is upon the Examiner. The Examiner must set forth express findings of fact regarding the analysis which supports the lack of written description conclusion. These findings should establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. The Examiner's comments on page 3 of the December 3, 2008 Office action are irrelevant because they go beyond what Applicants have claimed as their invention. Applicants have a duty to adequately describe that which is claimed as the invention.

Consider that Applicants' claim 14 states that the alternate piece (which includes a notification to the recipient regarding the status of their pre-personalized book and is generated to replace the rejected pre-personalized book) is in electronic format. What the Examiner is contending by rejecting the claim, and what the Board is asked to reconsider, is that one of ordinary skill in the art at the time the invention was made would not have recognized that the inventor was in possession of the invention as claimed (i.e., the inventor himself did not know how to generate an alternate piece of electronic format). The Examiner has not found any deficiency in the written description support for any of the method steps recited in independent claim 9, such as generating an alternate piece that replaces the rejected pre-personalized book. However, the Examiner contends that the statement of the alternate piece being in electronic format (something that is described at multiple locations throughout the specification, including specific examples of electronic format alternate pieces) represents a written description deficiency.

The knowledge of how to print/record data to a compact disc or send an e-mail message, for example was well within the knowledge of one of skill in the art at the time of the invention. In fact, these tasks are basic functions for virtually all personal computers sold over the past 10-15 years, and the skills to carry out such tasks were well known to most of the general public at the time of the invention, although clearly not in the particular context as presently claimed. Applicants assert that claim 14 recites a conventional technology being used in a new context (i.e., occurring in response to an action, or as part of a process, as not previously thought of). The application of a conventional technology in a new context does not in itself present a written description deficiency under 35 U.S.C. §112 due to some perceived deficiency in the description of the conventional technology.

With respect to the Examiner's burden to express findings of fact regarding the analysis which supports the lack of written description conclusion, this has clearly not been met, and the Examiner's demand for Applicants to provide evidence rebutting the rejection is unwarranted. With respect to an original claim (such as claim 14), MPEP §2163 (I)(A) states that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. Further, the claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is a) not adequately described in the specification; and b) which is not conventional in the art or known to one of ordinary skill in the art. When the alternate piece is in electronic format as described in claim 14, the specification describes that the alternate piece can be an e-mail message. The generation of e-mail messages is essentially a common, everyday software function that can be provided with a program loaded onto a local drive of a computer or available from a web-based provider. With respect to software, MPEP §2163 (I)(A) instructs that, as a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the function of the software because writing code for software is within the skill of the art, nor requiring undue experimentation, once its functions have been disclosed. Thus, at the very least, the disclosure of the alternate piece being an e-mail message provides adequate written description support for the claimed invention. Applicants submit that other forms of electronic media, although not strictly software-related, are not required to be described in any further detail than that provided because compact discs and magnetic tape, among other forms, in addition to the means necessary to generate them, are conventional among the general population, let alone to those of ordinary skill in the art.

Accordingly, Applicants respectfully request that the rejection be withdrawn and claim 14 be allowed.

Claim 20

Claim 20, read in its entirety (including the subject matter of claim 15 from which it depends), defines a method of replacing a rejected book on a binding line. The method comprises:

- generating a mailing list of recipients having a mailing order,
- assembling a pre-personalized book on the binding line for each recipient according to the mailing list,
- rejecting selective pre-personalized books,

generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and

replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order,

wherein the alternate piece is in electronic format.

Applicants submit that the subject matter of the rejected claims, specifically the alternate piece being in electronic format, is duly described in the specification at multiple locations. For example, reference is made to electronic format replacement pieces in the specification at page 3, lines 21-22; page 3, lines 29-31; page 5, lines 10-15; page 5, lines 17-20; page 6, lines 7-9; and page 6, line 30 to page 7, line 2.

According to the MPEP Section 2163, an adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. Additionally, the burden of proving the written description to be deficient is upon the Examiner. The Examiner must set forth express findings of fact regarding the analysis which supports the lack of written description conclusion. These findings should establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. The Examiner comments on page 3 of the December 3, 2008 Office action that the written description only presents doing an offline electronic format. This is not true. Fig. 5 does clearly label the step 110B as "GENERATE ALTERNATE PIECE OFF-LINE", but page 5, lines 10-11 of Applicants' originally filed specification describe that an alternate piece may be generated on the same binding line, on a different binding line, or in an off-line process. Page 6, line 32 also refers to an alternate piece being printed at the printer 38, which as shown in Fig. 1, is on the binding line 10. Whether the alternate piece is printed media or electronic media is irrelevant—the alternate piece can be generated on the binding line with a conventional device at the location of the printer 38.

Consider that Applicants' claim 20 states that the alternate piece (which is generated on the binding line and is of a different format from the rejected pre-personalized book that it replaces) is in electronic format. What the Examiner is contending by rejecting the claim, and what the Board is asked to reconsider, is that one of ordinary skill in the art at the time the invention was made would not have recognized that the inventor was in possession of the invention as

claimed (i.e., the inventor himself did not know how to generate an alternate piece of electronic format). The Examiner has not found any deficiency in the written description support for any of the method steps recited in independent claim 15, such as generating an alternate piece that replaces the rejected pre-personalized book. However, the Examiner contends that the statement of the alternate piece being in electronic format (something that is described at multiple locations throughout the specification, including specific examples of electronic format alternate pieces) represents a written description deficiency. This rejection can only be maintained under the presumption that one of ordinary skill in the art at the time of the invention was ignorant of what items of electronic format are and how to print/record data to compact discs or send e-mail messages, for example. This certainly is not the case, and as such, Applicants very obviously had possession of the invention defined by claim 20 at the time of filing.

With respect to the Examiner's burden to express findings of fact regarding the analysis which supports the lack of written description conclusion, this has clearly not been met, and the Examiner's demand for Applicants to provide evidence rebutting the rejection is unwarranted. With respect to an original claim (such as claim 20), MPEP §2163 (I)(A) states that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. Further, the claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is a) not adequately described in the specification; and b) which is not conventional in the art or known to one of ordinary skill in the art. When the alternate piece is in electronic format as described in claim 20, the specification describes that the alternate piece can be an e-mail message. As mentioned above with respect to claim 14, the generation of e-mail messages is essentially a common, everyday software function that can be provided with a program loaded onto a local drive of a computer or available from a web-based provider. With respect to software, MPEP §2163 (I)(A) instructs that, as a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the function of the software because writing code for software is within the skill of the art, nor requiring undue experimentation, once its functions have been disclosed. Thus, at the very least, the disclosure of the alternate piece being an e-mail message provides adequate written description support for the claimed invention. Applicants submit that the other forms of electronic media, although not strictly software-related, are not required to be described in any further detail than that provided because compact discs and magnetic tape, among other forms,

in addition to the means necessary to generate them, are well known to the general population, let alone to those of ordinary skill in the art.

Accordingly, Applicants respectfully request that the rejection be withdrawn and claim 20 be allowed.

2. Claim Rejections under 35 U.S.C. §112, ¶2

The Examiner rejects claims 25 and 26 as failing to comply with the definiteness requirement under 35 U.S.C. §112, second paragraph.

Specifically, the Examiner points out that there is insufficient antecedent basis for "the portion" in line 1 of claim 25 and in line 1 of claim 26.

MPEP 2173.05(e) instructs as follows:

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference... Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. (emphasis added)

Claims 25 and 26 each depend directly from claim 24, which recites that each pre-personalized book has therein a pre-personalized signature and further recites a step of "reprinting the pre-personalized signature of one of the rejected pre-personalized books". This is the only time in claim 24 that the action of "reprinting" is used. Claims 25 and 26 both refer to "the step of reprinting". Therefore, Applicants submit that the use of "the portion" in claims 25 and 26 clearly and unambiguously refers to the pre-personalized signature and that the lack of explicit antecedent basis alone is not sufficient to sustain a rejection under 35 U.S.C. §112, second paragraph, as the claims particularly point out and distinctly claim the subject matter which the applicant regards as his invention even without strict antecedent basis for "the portion".

Therefore, claims 25 and 26 are in compliance with 35 U.S.C. §112, second paragraph.

3. Claim Rejections under 35 U.S.C. §102(b) – Graushar

The Examiner rejects claims 1, 3, 4, 6, 9, 10, 11, 13, and 21-23 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,347,260 ("Graushar").

Claims 1, 3, 4, and 6

Claim 1 defines a binding method comprising:

generating a pre-personalized book on a binding line for a specific individual,
rejecting selective pre-personalized books, and
generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Graushar fails to disclose, teach or suggest at least generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual. Accordingly, Claim 1 is not anticipated by Graushar.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

As defined by Applicants' claim 1, the alternate piece must be of an alternate medium compared to the pre-personalized book. As one example of this concept, if the pre-personalized book was a magazine, the alternate piece must be a medium other than a magazine. The alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media forms, some of which are printed and some of which are electronic. See *e.g.*, Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar discloses rejecting a book and replacing it with another book. Thus, the type of communicative medium (i.e., signatures and inserts that constitute a book) of the replacement is exactly the same as the rejected book and is not "of an alternate medium," although the information contained in the generic book of Graushar may be slightly different from the rejected book. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual medium by which

informational content is conveyed. Applicants' claim defines the latter, while the art cited of record addresses only the former.

MPEP 2111 and 2111.01 provide guidance on claim language interpretation. Applicants appreciate the Office's need to broadly interpret claim language, but insist that the interpretation given by the Examiner to "of an alternate medium" in order to justify the rejection goes beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what alternate forms of media actually are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that the Examiner has considered the claim language with the broadest interpretation imaginable.

Therefore, Graushar fails to disclose, teach or suggest generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual, as claimed.

Claim 1 is allowable over Graushar for this and other reasons. Claims 3, 4, and 6 depend from Claim 1 and are allowable over Graushar for at least the same reasons.

Claims 9, 10, 11, and 13

Claim 9 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized book for each recipient on a binding line,
- rejecting one of the pre-personalized books,
- identifying the recipient of the rejected pre-personalized book, and
- generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book.

Graushar fails to disclose, teach or suggest at least replacing a rejected book with an alternate piece that includes a notification to the recipient. Accordingly, Claim 9 is not anticipated by Graushar.

The disclosure of Graushar is related to replacing a pre-personalized book with a generic book. On page 6 of the December 3, 2008 Office action, the Examiner states that the generic book of Graushar inherently notifies the recipient of the status simply by the book being generic. In order to support a rejection under 35 U.S.C. §102(b) based on inherency, Graushar must actually disclose something that necessarily results in Applicants' claimed method (see MPEP 2112 IV). Such a rejection cannot be maintained based on possibility or even probability of occurrence. In the instant case, Applicants submit that the Examiner has interpreted the claims as broadly as imaginable, rather than "as broadly as their terms reasonably allow" (see MPEP 2111 and 2111.01).

Applicants' claim positively recites "generating an alternate piece...wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book." Given its plain meaning, the claim is very clear that an actual notification is included with the alternate piece, not merely a "clue" that might lead one to speculate about the status of their pre-personalized book. This claim language is supported in the specification (*page 6, lines 11-14*). Therefore, to say that the mere delivery of a generic book is the same as the step in Applicants' method is a misinterpretation of 35 U.S.C. §102(b) if the claim language is given its proper, plain meaning (MPEP 2111.01) and the Examiner gives the claims the broadest reasonable interpretation consistent with the specification (MPEP 2111). Applicants have made no express attempt to broaden or change the meaning of the phrases included in the claim. Thus, the Examiner's interpretation is unjustifiably broad in order to construe Graushar's generic book as anticipating Applicants' claim. The fact that a recipient of Graushar's generic book can be aware of the intended book and could possibly figure out something about the status of the intended book (page 6, Office action dated December 3, 2008) is not the same as providing an alternate piece including actual notification as recited in Applicants' claimed method.

Therefore, Graushar fails to disclose, teach or suggest generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book, as claimed.

Claim 9 is allowable over Graushar for this and other reasons. Claims 10, 11, and 13 depend from Claim 9 and are allowable over Graushar for at least the same reasons.

Claims 21-23

Claim 21 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized printed product off-line for selected recipients on the mailing list,
- loading the pre-personalized printed products adjacent a binding line,
- assembling a book for each recipient including a respective pre-personalized printed product,
- rejecting selective recipients' books,
- removing the rejected books from the binding line, and
- generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

Graushar fails to disclose, teach, or suggest at least the following limitation of Claim 21:

generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

As defined by Applicants' Claim 21, the alternate piece must be a different medium than the pre-personalized printed product. As one example of this concept, if the pre-personalized printed product was a magazine page, the alternate piece must be a medium other than a magazine page. The alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media forms, some of which are printed and some of which are electronic. See e.g., Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar

discloses rejecting a book and replacing it with another book. Thus, the type of communicative medium (i.e., signatures and inserts that constitute a book) of the replacement is exactly the same as the rejected book and is not “of a different medium,” although the information contained in the generic book of Graushar may be different from the rejected book. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual medium by which informational content is conveyed. Applicants’ claim defines the latter, while the art cited of record addresses only the former.

As stated above, Applicants insist that the interpretation given by the Examiner to “of a different medium” in order to justify the rejection goes beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what alternate forms of media actually are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that the Examiner has considered the claim language with the broadest interpretation imaginable.

Therefore, Graushar does not disclose, teach or suggest assembling a book for each recipient comprising a respective pre-personalized printed product and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product, as claimed.

Claim 21 is allowable over Graushar for this and other reasons. Claims 22 and 23 depend from claim 21 and are allowable over Graushar for at least the same reasons.

4. Claim Rejections under 35 U.S.C. §102(b) – Gruber

The Examiner rejects claims 24 and 25 as being anticipated under 35 U.S.C. §102(b) by United States Patent No. 4,395,031 (“Gruber”).

Claims 24 and 25

Claim 24 defines a binding method comprising:

generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature,

rejecting selective pre-personalized books,

reprinting the pre-personalized signature of one of the rejected pre-personalized books, and

regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Initially, Applicants would like to make sure that the terminology in the claim is absolutely clear so that proper distinction can be made with respect to the prior art. As defined in Applicants' originally-filed specification (see page 1, lines 26-30 and page 3, lines 28-33), a pre-personalized signature is a signature that contains personalized information or indicia prior to being fed onto a binding line.

As evidenced by the "TECHNICAL FIELD OF THE INVENTION" and the "BACKGROUND OF THE INVENTION", the objective of Gruber's apparatus and method is to cure a deficiency in the prior art regarding providing proper correlation between customized information printed on both the inside pages and the outside cover of a book. In the Examiner's own citation of Gruber (column 5, lines 21-26), it is described that customized information is printed on both the inside pages 31 and the exterior cover pages 33 at a printing station 16 (Fig. 1). The customized printing occurs on the pages only after the pages have been discharged from the feeders 10 onto the conveyor 12. In fact, Gruber claims to prevent any printing of customized information at the printing station 16 on a book that is found to be rejectable (see column 16, lines 52-55; column 17, lines 17-19; column 18, lines 42-45 and 54-59). Thus, the rejecting and reprinting disclosed by Gruber (such as at column 19, lines 15-21) is the rejecting and reprinting of books of signatures 29 that were never personalized. Although Gruber generally discloses reprinting missing books, the teachings of the reference as a whole are fundamentally different from that which Applicants are claiming as the invention of claim 24. For at least these reasons, Gruber does not teach or suggest the method of generating books that each include a pre-personalized signature, rejecting selective pre-personalized books, and reprinting the pre-personalized signature for inclusion with a regenerated book.

Claim 24 is allowable over Gruber for this and other reasons. Claims 25 and 26 depend from Claim 24 and are allowable over Gruber for at least the same reasons.

5. Claim Rejections under 35 U.S.C. §102(e) – Graushar ‘219

The Examiner rejects claims 1-25, and 28-31 as being anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,694,219 (“Graushar ‘219”).

Claims 1-8

Claim 1 defines a binding method comprising:

generating a pre-personalized book on a binding line for a specific individual,
rejecting selective pre-personalized books, and
generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

As described above with respect to claim 24, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Graushar ‘219 discloses (column 5, lines 2-12) personalization taking place at a printing area 35 that is downstream of a stitcher 30 and a trimmer 34. Therefore, the general nature of the teachings of Graushar ‘219 is limited in applicability to the invention defined in claim 1, because Graushar ‘219 does not contemplate generating pre-personalized books.

Furthermore, Graushar ‘219 does not disclose, teach or suggest at least generating an alternate piece, of an alternate medium compared to a pre-personalized book, in place of a rejected pre-personalized book to be delivered to a specific individual. Accordingly, Claim 1 is not anticipated by Graushar ‘219 under 35 U.S.C. §102(e).

Graushar ‘219 discloses a method and apparatus for assembling a magazine with a CD or a DVD. The Examiner has pointed to portions of the disclosure of Graushar ‘219 that state that a rejected magazine may be replaced by another magazine that is standard, customized, personalized, or customized/personalized (see column 5, 24-33).

As defined by Applicants' claim 1, the alternate piece must be of an alternate medium compared to the pre-personalized book. As one example of this concept, if the pre-personalized book was a magazine, the alternate piece must be a medium other than a magazine. To be considered an alternate medium, the alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media forms, some of which are printed and some of which are electronic. See e.g., Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar '219 discloses rejecting a magazine and replacing it with another magazine (whether customized, personalized, etc.). Thus, the physical medium (i.e., the substantive means by which the information is communicated) of the replacement is exactly the same as the rejected original, although the content in the replacement magazine of Graushar '219 may be slightly different from the rejected magazine. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual medium by which informational content is conveyed. Applicants' claim defines the latter, while the art cited of record addresses only the former.

As stated above, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that, in order to justify the rejection, the interpretation given by the Examiner to the phrase "of an alternate medium" goes clearly beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what alternate forms of media are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification (MPEP 2111). Applicants submit that the Examiner has extended the interpretation of the claim language beyond what can be considered "reasonable" as based on the plain meaning and in light of Applicants' specification as it would be interpreted by one of ordinary skill in the art.

Therefore, Graushar '219 fails to teach or suggest generating an alternate piece, of an alternate medium compared to a pre-personalized book, in place of a rejected pre-personalized book to be delivered to a specific individual, as claimed.

Claim 1 is allowable over Graushar '219 for this and other reasons. Claims 2-8 depend from Claim 1 and are allowable over Graushar '219 for at least the same reasons.

Claims 9-14

Claim 9 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized book for each recipient on a binding line,
- rejecting one of the pre-personalized books,
- identifying the recipient of the rejected pre-personalized book, and
- generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book.

As described above, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Graushar '219 discloses (column 5, lines 2-12) personalization taking place at a printing area 35 that is downstream of a stitcher 30 and a trimmer 34. Therefore, the general nature of the teachings of Graushar '219 is limited in applicability to the invention defined in claim 1, because Graushar '219 does not contemplate generating pre-personalized books.

Furthermore, Graushar '219 does not disclose, teach or suggest at least replacing a rejected book with an alternate piece that includes a notification to the recipient. Accordingly, Claim 9 is not anticipated by Graushar '219 under 35 U.S.C. §102(e).

As discussed briefly above, Graushar '219 discloses the replacement of rejected magazines with other magazines. On pages 12-13 of the December 3, 2008 Office action, the Examiner states that the replacement magazine of Graushar '219 includes notification to the recipient regarding the status of their pre-personalized book because the reference teaches of customized information in the replacement, "which can easily be notification information". In order to support a rejection under 35 U.S.C. §102, Graushar '219 must actually disclose, either explicitly or inherently, the claimed invention, including all of the method steps recited in Applicants' claim. The rejection simply cannot be maintained based on the supposed ability of a prior art device to perform an action—the reference must actually contemplate that the action

occur. In the instant case, Graushar '219 defines customization in the background of the invention, stating that magazine printers commonly customize magazines by including particular signatures within a magazine based on known characteristics of the recipient. Designated signatures, stored in different hoppers along a binding line, are selectively placed onto the binding line such that magazines are assembled using a particular set of designated signatures based on a recipient's profile. Absent Examiner's hindsight in reading the pending claims, there is nothing in the disclosure of Graushar '219 that suggests providing notification regarding the status of anything.

Therefore, Graushar '219 fails to teach or suggest replacing a rejected book with an alternate piece that includes a notification to the recipient, as claimed.

Claim 9 is allowable over Graushar '219 for this and other reasons. Claims 10-14 depend from Claim 9 and are allowable over Graushar '219 for at least the same reasons.

Claims 15-20

Claim 15 defines a method of replacing a rejected book on a binding line. The method comprises:

- generating a mailing list of recipients having a mailing order,
- assembling a pre-personalized book on the binding line for each recipient according to the mailing list,
- rejecting selective pre-personalized books,
- generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and
- replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

As described above, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Graushar '219 discloses (column 5, lines 2-12) personalization taking place at a printing area 35 that is downstream of a stitcher 30 and a trimmer 34. Therefore, the general nature of the teachings of Graushar '219 is limited in applicability to the invention defined in claim 1, because Graushar '219 does not contemplate assembling pre-personalized books.

Furthermore, Graushar '219 does not disclose, teach or suggest at least generating an alternate piece on the binding line, the alternate piece being of a different format from a rejected pre-personalized book. Accordingly, Graushar '219 does not anticipate the subject matter of independent claim 15 under 35 U.S.C. §102(e).

Graushar '219 discloses a method and apparatus for assembling a magazine with a CD or a DVD. The Examiner has pointed to portions of the disclosure of Graushar '219 that state that a rejected magazine may be replaced by another magazine that is either standard, customized, personalized, or customized/personalized.

As defined by Applicants' claim 15, the alternate piece must be of a format different from the rejected pre-personalized book. As one example of this concept, if the pre-personalized book was a magazine, the alternate piece must be of a format other than a magazine. To be considered a different format, the alternate piece could be a different printed format or any type of electronic format. As defined in Applicants' specification, the alternate piece may take one of many forms, some of which are printed and some of which are electronic. See e.g., Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar '219 discloses rejecting a magazine and replacing it with another magazine (whether customized, personalized, etc.). Thus, the physical format (i.e., the substantive means by which the information is communicated) of the replacement is exactly the same as the rejected original, although the content in the replacement magazine of Graushar '219 may be slightly different from the rejected magazine. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual format by which informational content is conveyed. Applicants' claim defines the latter, while the art cited of record addresses only the former.

As stated above, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that, in order to justify the rejection, the interpretation given by the Examiner to the phrase "format different from the rejected pre-personalized book" goes clearly beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the

specification consistent with the conventional meaning of what different media formats are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification (MPEP 2111). Applicants submit that the Examiner has considered the claim language with the broadest interpretation imaginable.

Therefore, Graushar '219 fails to teach or suggest generating an alternate piece on the binding line, the alternate piece being of a different format from a rejected pre-personalized book, as claimed.

Claim 15 is allowable over Graushar '219 for this and other reasons. Claims 16-20 depend from Claim 15 and are allowable over Graushar '219 for at least the same reasons.

Claims 21-23

Claim 21 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized printed product off-line for selected recipients on the mailing list,
- loading the pre-personalized printed products adjacent a binding line,
- assembling a book for each recipient including a respective pre-personalized printed product,
- rejecting selective recipients' books,
- removing the rejected books from the binding line, and
- generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

As described above, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Graushar '219 discloses (column 5, lines 2-12) personalization taking place at a printing area 35 that is downstream of a stitcher 30 and a trimmer 34. Therefore, the general nature of the teachings of Graushar '219 is limited in applicability to the invention defined in claim 1, because Graushar '219 does not contemplate generating a pre-personalized printed product off-line.

Furthermore, Graushar '219 does not disclose, teach, or suggest at least generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

As discussed above with respect to claim 1, Graushar '219 discloses that a rejected magazine may be replaced by another magazine that is standard, customized, personalized, or customized/personalized (see column 5, 24-33).

As defined by Applicants' claim 21, the alternate piece must be a different medium than the pre-personalized printed product. As one example of this concept, if the pre-personalized book was a magazine, the alternate piece must be a medium other than a magazine. To be considered a different medium, the alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media forms, some of which are printed and some of which are electronic. See *e.g.*, Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar '219 discloses rejecting a magazine and replacing it with another magazine (whether customized, personalized, etc.). Thus, the physical medium (i.e., the substantive means by which the information is communicated) of the replacement is exactly the same as the rejected original, although the content in the replacement magazine of Graushar '219 may be slightly different from the rejected magazine. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual medium by which informational content is conveyed. Applicants' claim defines the latter, while the art cited of record addresses only the former.

As stated above, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that, in order to justify the rejection, the interpretation given by the Examiner to the phrase "of a different medium" goes clearly beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what different forms of media are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the

specification (MPEP 2111). Applicants submit that the Examiner has considered the claim language with the broadest interpretation imaginable.

Therefore, Graushar '219 does not disclose, teach or suggest assembling a book for each recipient comprising a respective pre-personalized printed product and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product, as claimed.

Claim 21 is allowable over Graushar '219 for this and other reasons. Claims 22 and 23 depend from claim 21 and are allowable over Graushar '219 for at least the same reasons.

Claims 24 and 25

Claim 24 defines a binding method comprising:

- generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature,
- rejecting selective pre-personalized books,
- reprinting the pre-personalized signature of one of the rejected pre-personalized books, and
- regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

The Examiner contends that column 4, lines 9-18 of Graushar '219 discloses printing customized signatures online. Column 4, lines 9-18 of Graushar '219 actually describes how magazines are "customized" by being assembled of a designated group of signatures from the hoppers. Graushar '219 further discloses that magazines are "personalized" by printing personalized address information on the magazine cover and/or a compact disc 21 with a printer 36 on the bindery line 10 (column 5, lines 2-12) that is located downstream of a stitcher 30 and a trimmer 34.

In contrast, and as described above, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Upon careful examination of the language of claim 24, it should be seen that Applicants have defined a method that is fundamentally different from that disclosed by

Graushar '219. Claim 24 defines that each pre-personalized book is generated including at least one pre-personalized signature. Essentially, it could be said that Graushar '219 discloses magazines that are post-personalized (i.e., the personalized information is added after assembly of the magazine). Thus, the relevant portion of the disclosure of Graushar '219 teaches the opposite of what is claimed.

Beyond the undeniable difference between pre- and post-personalized products and the different sets of circumstances and challenges associated with each, claim 24 further recites steps of reprinting the pre-personalized signature of one of the rejected pre-personalized books, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature. These method steps further relate to and build upon the concept of the pre-personalized book and the pre-personalized signature therein and are not contemplated by Graushar '219 due to the fundamental difference between the currently claimed invention and a post-assembly personalization method as disclosed by Graushar '219.

For at least these reasons, Graushar '219 does not teach or suggest the method of generating books that each include a pre-personalized signature, rejecting selective pre-personalized books, reprinting the pre-personalized signature for inclusion with a regenerated book, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Claim 24 is allowable over Graushar '219 for this and other reasons. Claim 25 depends from claim 24 and is allowable over Graushar '219 for at least the same reasons.

Claims 28-30

Claim 28 defines a binding method comprising:

generating a mailing list of recipients,

generating a pre-personalized printed product for each recipient,

assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece,

rejecting selective books,

removing the rejected books from respective spaces along the binding line,

generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and

inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

The Examiner cites passages from columns 4 and 5 of Graushar '219 and contends that they disclose assembling books including respective pre-personalized pieces, generating an alternate pre-personalized piece (of a different medium than the pre-personalized printed product) for each recipient whose book was rejected, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book. As discussed in some detail above, the Examiner has clearly confused several facts of the disclosure of Graushar '219. First of all, Graushar '219 discloses that magazines are "customized" by being assembled of a designated group of signatures from the hoppers. Graushar '219 further discloses that magazines are "personalized" by printing personalized address information on the magazine cover and/or a compact disc 21 with a printer 36 on the bindery line 10 (column 5, lines 8-12) that is located downstream of a stitcher 30 and a trimmer 34. Therefore, the magazines are not assembled from any pre-personalized pieces, they can only be personalized post-assembly and post-trimming.

Graushar '219 further fails to disclose generating any alternate piece (let alone a pre-personalized piece) that is of a different medium than the pre-personalized printed product that was rejected. Instead, Graushar '219 very clearly recites at column 5, lines 24-33 that a rejected magazine is replaced with another magazine, whether standard, customized, personalized, etc. Even though the original magazine and the replacement magazine may have slightly altered content, both are provided as a collection of printed pages in the form of a magazine.

As defined by Applicants' Claim 28, the alternate pre-personalized piece must be of a different medium compared to the pre-personalized printed product. As one example of this concept, if the pre-personalized printed product was a magazine, the alternate pre-personalized piece must be some form of communicative media other than a magazine. To be considered a different medium, the alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media

forms, some of which are printed and some of which are electronic. See e.g., Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9.

Conversely, Graushar '219 discloses that the physical medium (i.e., the substantive means by which the information is communicated) of a replacement is exactly the same as the rejected original, although the content in the replacement magazine of Graushar '219 may be slightly different from the rejected magazine. Applicants submit that the Examiner has confused the concept of varying content with that of varying the actual medium by which informational content is conveyed. Applicants' claim defines the latter, while the art cited of record addresses only the former.

As stated above, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification. Applicants submit that, in order to justify the rejection, the interpretation given by the Examiner to the phrase "of a different medium" goes clearly beyond the broadest reasonable interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what different forms of media are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest reasonable interpretation, consistent with the specification (MPEP 2111). Applicants submit that the Examiner has considered the claim language with the broadest interpretation imaginable.

Lastly, Graushar '219 fails to disclose inserting an alternate pre-personalized piece into the space previously occupied by a respective rejected book. The Examiner cites to a passage of Graushar '219 that supposedly describe immediate reordering of the rejected book, therefore maintaining the mailing order and even the same spot in the bundle. The cited passage (column 5, lines 27-35) states

The CD reading machine 38 sends information to the control system 23 which subsequently directs the assembly system to fabricate a replacement magazine into which the CD 21 may be inserted. The replacement magazine may be either standard, customized, personalized, or customized/personalized. After a replacement magazine is ordered, the rejected magazines are sent to a storage area 40 for recycling or disposal.

It is entirely unclear why the Examiner believes that this passage of Graushar '219 discloses or somehow suggests the method defined by claim 28.

Therefore, Graushar '219 fails to disclose, teach or suggest assembling books including respective pre-personalized pieces, generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book, as claimed.

Claim 28 is allowable for this and other reasons. Claims 29 and 30 depend from claim 28 and are allowable for at least the same reasons.

Claim 31

Claim 31 defines a method of replacing a rejected book on a binding line, comprising:

- generating a mailing list of recipients,
- assembling a pre-personalized book on the binding line for each recipient,
- rejecting selected pre-personalized books,
- replacing a first rejected book with a generic book,
- replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and
- replacing a third rejected book with a different medium.

As described above, something that is pre-personalized contains and/or is created from pieces that include personalized information or indicia prior to being fed onto a binding line. Graushar '219 discloses (column 5, lines 2-12) personalization taking place at a printing area 35 that is downstream of a stitcher 30 and a trimmer 34. Therefore, the general nature of the teachings of Graushar '219 is limited in applicability to the invention defined in claim 1, because Graushar '219 does not contemplate assembling pre-personalized books.

Furthermore, Graushar '219 fails to disclose, teach or suggest at least replacing a rejected book with a different medium. Accordingly, the subject matter of independent claim 15 is not anticipated by Graushar '219 under 35 U.S.C. §102(e).

The disclosure of Graushar '219 contemplates replacing a rejected magazine with a replacement magazine that is standard, customized, personalized, or customized/personalized. The Examiner states that, because Applicants have not set forth a specific definition of what is meant by "different medium", that it has been broadly interpreted. However, the lack of a specific definition for a phrase in a claim does not give the Office cause for giving that phrase the broadest meaning imaginable, but rather, the broadest reasonable meaning, consistent with the specification (MPEP 2111 and 2111.01). One of ordinary skill in the art would appreciate that the last stanza of this particular claim refers specifically to replacing a rejected book with something that is not a book. The Examiner's quotation to Applicants' specification on page 20 of the Office action dated December 3, 2008 lists examples of potential replacement pieces, including books and several examples of non-book media. Applicants' mere contemplation of replacing a rejected book with a piece of either the same or different medium does not somehow give reason to interpret the claimed "replacing a third rejected book with a different medium" as including replacing a book with a book having slightly altered content (as taught by Graushar '219), which is clearly the same medium—they are both books.

Therefore, Graushar '219 fails to teach or suggest replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium, as claimed.

Accordingly, claim 31 is allowable over Graushar '219 for at least these reasons. Applicants respectfully request withdrawal of the rejection and allowance of claim 31.

6. Claim Rejections under 35 U.S.C. §103(a) – Graushar in view of Graushar '219

The Examiner rejects claims 2, 5, 7, 8, 12, 14, and 29 as being unpatentable under 35 U.S.C. §103(a) over Graushar in view of Graushar '219.

Claims 2, 5, 7, and 8

Claims 2, 5, 7, and 8 depend from Claim 1, which is discussed separately herein. Claim 2 is directed to the method of claim 1 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information. Claim 5 is directed to the method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line. Claim 7 is directed to the method of claim 1

wherein the alternate piece is a printed product, particularly a post card. Claim 8 is directed to the method of claim 1 wherein the alternate piece is in electronic format. While Graushar '219 is generally relevant to magazines provided with electronic media, such as CDs or DVDs, it fails to cure the deficiencies of the base Graushar reference with respect to independent Claim 1.

Particularly, Graushar discloses replacing books (which may be demographically customized) with generic books, and Graushar '219 discloses replacing rejected magazines with standard, customized, personalized, or customized/personalized magazines. Thus, neither Graushar nor Graushar '219 contemplates generating an alternate piece, of an alternate medium compared to a pre-personalized book, in place of each rejected pre-personalized book to be delivered to a specific individual. Absolutely nothing of record has shown why it would have been obvious to one of skill in the art to modify the prior art in this regard.

Claims 2, 5, 7, and 8 are allowable over Graushar in view of Graushar '219.

Claims 12 and 14

Claims 12 and 14 depend from Claim 9, which is discussed separately above. Claim 12 is directed to the method of claim 9 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line. Claim 14 is directed to the method of claim 9 wherein the alternate piece is in electronic format. While Graushar '219 is generally relevant to magazines provided with electronic media, such as CDs or DVDs, it fails to cure the deficiencies of Graushar with respect to independent Claim 9.

Particularly, neither Graushar nor Graushar '219 contemplates generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book, as claimed. Absolutely nothing of record has shown why it would have been obvious to one of skill in the art to modify the prior art in this regard.

Claims 12 and 14 are allowable over Graushar in view of Graushar '219.

Claim 29

Claim 29 depends from claim 28 and further recites that generating the alternate pre-personalized piece is done on the binding line. Applicants have previously overcome a rejection

under 35 U.S.C. §102 to claim 28 based on Graushar. The disclosure of Graushar '219 fails to cure the known deficiencies of Graushar with respect to independent Claim 28.

Particularly, Graushar '219 fails to contemplate generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book. Absolutely nothing of record has shown why it would have been obvious to one of skill in the art to modify the prior art in this regard.

Claim 29 is allowable over Graushar in view of Graushar '219.

7. Claim Rejections under 35 U.S.C. §103(a) – Gruber in view of Anderson

The Examiner rejects claims 24 and 26 as being unpatentable under 35 U.S.C. §103(a) over Gruber in view of United States Patent No. 3,819,173 ("Anderson"). Although page 30 of the December 3, 2008 Office action lists only claim 26 as being rejected, and page 31 begins with a discussion of "claim 26", Applicants understand the rejection to be made against claims 24 and 26 based on the detailed reasoning for the Examiner's rejection, and the statement at the bottom of page 31 of the action that discusses the rejection of claim 26 "as applied to claim 24".

Claims 24 and 26

Claim 24 defines a binding method comprising:

- generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature,
- rejecting selective pre-personalized books,
- reprinting the pre-personalized signature of one of the rejected pre-personalized books, and
- regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Initially, Applicants submit that the rejection as stated on pages 30-31 of the December 3, 2008 Office action fails to meet the minimum burden of establishing a prima facie case of

obviousness insofar as the Examiner has not clearly articulated and provided an explicit analysis regarding the reasons why the claimed invention would have been obvious. Specifically, the Examiner's explanation of the rejection does not seem to match with the stated rejection. The Examiner first sets forth that the claim is obvious over Gruber in view of Anderson. However, on page 31 of the December 3, 2008 Office action, the Examiner proceeds to describe how each and every limitation of claim 24 is said to be taught by Anderson.

Applicants have previously overcome a rejection to claim 24 under 35 U.S.C. §102(b) in view of Anderson.

After the Examiner describes how Anderson teaches all the limitations of the claim, it is generically stated that it would have been obvious to provide the feeders of Gruber with pre-personalized signatures as taught by Anderson in order to allow for mass or easier production of personalized printed products. Applicants are unable to decipher whether the Examiner thinks that Anderson alone anticipates the claim (as stated) or whether a teaching of Anderson is somehow being incorporated into the invention of Gruber (as later stated).

Although the particular reasoning behind the Examiner's rejection is unidentifiable, the actual disclosures of the cited references are able to be analyzed and shown to be deficient in teaching Applicants' invention.

As discussed above with respect to the rejection in view of Gruber under 35 U.S.C. §102(b), Gruber discloses a method that includes reprinting books that were never personalized, in that none of the signatures from the feeders 10 are disclosed as being pre-personalized, and printing of custom information at the printing station 16 is specifically avoided on any rejectable book.

Anderson discloses that magazines, whether new or reordered, are assembled from signatures already in the inserter 10. Thus, the signatures are not reprinted for a particular subscriber's magazine, nor are the signatures pre-personalized. The Examiner correctly identifies that, when a magazine is re-ordered, signatures are again fed from the feeders. Applicants submit that the feeding of a signature from a feeder is not sufficient to anticipate the claimed step of reprinting a pre-personalized signature.

Although Anderson discloses reprinting and punching a renewal card, claim 24 refers specifically to a signature being reprinted. The renewal card of Anderson is not a signature as characterized by Applicants' specification, Anderson's specification, or as understood by one of ordinary skill in the art.

Further, Anderson fails to disclose regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature, in part, because as stated above Anderson fails to disclose reprinting the pre-personalized signatures and, therefore, cannot regenerate the rejected pre-personalized book in the manner claimed.

Therefore, neither Gruber, nor Anderson, nor the combination thereof, contemplates reprinting the pre-personalized signature of one of the rejected pre-personalized books and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature, as claimed. Absolutely nothing of record has shown why it would have been obvious to one of skill in the art to modify the prior art in this regard.

Claim 24 is allowable over Gruber in view of Anderson for this and other reasons. Claim 26 depends from claim 24 and is allowable over Gruber in view of Anderson for at least the same reasons.

Respectfully submitted,



Jayson L. Hongsermeier
Reg. No. 61,929

Docket No.: 077047-9497-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

(viii) *Claims appendix*

1. A binding method comprising:
generating a pre-personalized book on a binding line for a specific individual;
rejecting selective pre-personalized books; and
generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.
2. The method of claim 1 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information.
3. The method of claim 1 wherein the pre-personalized book includes a pre-personalized signature.
4. The method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line.
5. The method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.
6. The method of claim 1 wherein the alternate piece is a printed product.
7. The method of claim 6 wherein the alternate piece is a postcard.

8. The method of claim 1 wherein the alternate piece is in electronic format.

9. A binding method comprising:
generating a mailing list of recipients;
generating a pre-personalized book for each recipient on a binding line;
rejecting one of the pre-personalized books;
identifying the recipient of the rejected pre-personalized book; and
generating an alternate piece that replaces the rejected pre-personalized book,
wherein the alternate piece includes a notification to the recipient regarding the status of
their pre-personalized book.
10. The method of claim 9 wherein the alternate piece is a printed product.
11. The method of claim 9 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the pre-personalized information.
12. The method of claim 9 wherein the act of generating the alternate piece includes
printing the alternate piece on the binding line.
13. The method of claim 9 wherein the act of generating the alternate piece includes
printing the alternate piece off-line with respect to the binding line.
14. The method of claim 9 wherein the alternate piece is in electronic format.

15. A method of replacing a rejected book on a binding line, the method comprising:
generating a mailing list of recipients having a mailing order;
assembling a pre-personalized book on the binding line for each recipient
according to the mailing list;
rejecting selective pre-personalized books;
generating an alternate piece on the binding line, the alternate piece being of a
format different from the rejected pre-personalized book; and
replacing the rejected pre-personalized book with the alternate piece, the
alternate piece positioned on the binding line to maintain the mailing order.
16. The method of claim 15 wherein the alternate piece is a postcard.
17. The method of claim 15 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information of the pre-personalized book.
18. The method of claim 15 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes different pre-personalized information of the pre-personalized book.
19. The method of claim 15 wherein the alternate piece is a printed product.
20. The method of claim 15 wherein the alternate piece is in electronic format.

21. A binding method comprising:

- generating a mailing list of recipients;
- generating a pre-personalized printed product off-line for selected recipients on the mailing list;
- loading the pre-personalized printed products adjacent a binding line;
- assembling a book for each recipient including a respective pre-personalized printed product;
- rejecting selective recipients' books;
- removing the rejected books from the binding line; and
- generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

22. The binding method of claim 21 wherein the alternate piece includes at least a portion of the pre-personalized information contained in the pre-personalized printed product for a given selected recipient.

23. The binding method of claim 21 and further including the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected.

24. A binding method comprising:
generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature;
rejecting selective pre-personalized books;
reprinting the pre-personalized signature of one of the rejected pre-personalized books; and
regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

25. The binding method of claim 24 wherein the step of reprinting the portion is done on the binding line.

26. The binding method of claim 24 wherein the step of reprinting the portion is done offline with respect to the binding line.

27. (Canceled)

28. A binding method comprising:
generating a mailing list of recipients;
generating a pre-personalized printed product for each recipient;
assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece;
rejecting selective books;
removing the rejected books from respective spaces along the binding line;
generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product; and
inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

29. The binding method of claim 28 wherein generating the alternate pre-personalized piece is done on the binding line.

30. The binding method of claim 28 wherein generating the alternate pre-personalized piece is done off line with respect to the binding line.

31. A method of replacing a rejected book on a binding line, the method comprising:
- generating a mailing list of recipients;
 - assembling a pre-personalized book on the binding line for each recipient;
 - rejecting selected pre-personalized books;
 - replacing a first rejected book with a generic book;
 - replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been; and
 - replacing a third rejected book with a different medium.

(ix) *Evidence appendix*

None.

(x) *Related proceedings appendix*

None.